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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,154	07/16/2003	James L. Sumiejski	3218R	1207
26645	7590	07/18/2006	EXAMINER	
THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,154

Applicant(s)

SUMIEJSKI ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Please note the examiner of record has been changed. The new examiner is Vickey Ronesi.
2. All outstanding objections and rejections, except for those given below, are withdrawn in light of applicant's amendment filed 5/1/2006.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

5. Claims 1, 2, 4, 5, 8-10, 14, and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiejski et al (US 6,103,673) in view of Vinci et al (US 5,334,329).

The rejection is adequately set forth in paragraph 6 of Office action mailed 12/5/2005 and is incorporated here by reference.

6. Claims 6, 7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiejski et al (US 6,103,673) in view of Vinci et al (US 5,334,329) and further in view of Tagliamonte et al (US 6,528,458).

The rejection is adequately set forth in paragraph 7 of Office action mailed 12/5/2005 and is incorporated here by reference.

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7. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiejski et al (US 6,103,673) in view of Vinci et al (US 5,334,329) and further in view of Farng et al (US 5,006,270).

The rejection is adequately set forth in paragraph 8 of Office action mailed 12/5/2005 and is incorporated here by reference.

Response to Arguments

8. Applicant's arguments filed 5/1/2006 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Sumiejski discloses a wide variety of phosphorus-containing compounds with no motivation to pick a hydrocarbyl phosphite, wherein the hydrocarbyl groups contains at least 12 carbon atoms and (B) that unexpectedly improved properties over Sumiejsk are obtained by using a hydrocarbyl phosphite with at least 12 carbon atoms in the hydrocarbyl group.

With respect to argument (A), while Sumiejski teaches a variety of phosphorus-containing compounds, Sumiejski clearly teaches the use of hydrocarbyl phosphites with at least 12 carbon atoms in the hydrocarbyl group (col. 11, lines 9-52). The examiner acknowledges that the examples do not contain such, however, case law holds "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

With respect to argument (B), the declaration filed 5/1/2006 and the data in the specification as originally filed have be fully considered, however, the data is insufficient to

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establish unexpected and surprising results for the presently claimed invention. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). In particular, the exemplified hydrocarbyl phosphites, C₁₄ dialkyl phosphite and mixtures of C₁₆ and C₁₈ dialkyl phosphites, are not reasonably commensurate in scope with the presently claimed “hydrocarbyl phosphite, wherein the hydrocarbyl group contains at least 12 carbon atoms.” Furthermore, only one type each of condensation product of a fatty acid with a polyamide, borate ester, and borated dispersant is exemplified. Case law also holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/10/2006
Vickey Ronesi

VR

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